

AP/1653 IFW

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **June 14, 2005**.

April Reeves
April Reeves

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Q. Liu *et al.*

Application No.: 09/989,994

Filed: November 20, 2001

For: POSITION DEPENDENT
RECOGNITION OF GNN NUCLEOTIDE
TRIPLETS BY ZINC FINGERS

Examiner: Karen C. Carlson

Group Art Unit: 1653

Confirmation No.: 1661

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed please find the following:

1. Reply to Decision on Petition: 3 pages
2. Return postcard

It is believed that no fee is due in connection with this communication.

Please address all correspondence to:

Dahna S. Pasternak
Robins & Pasternak LLP
1731 Embarcadero Road
Suite 230
Palo Alto, CA 94303

Telephone: (650) 493-3400
FAX: (650) 493-3440

Respectfully submitted,

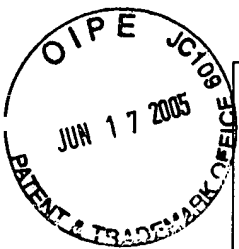
Date: June 14, 2005

By: Sean Brennan

Sean M. Brennan
Registration No. 39,917

Sangamo BioSciences, Inc.
501 Canal Blvd., Suite A100
Richmond, California 94804

Telephone: (510) 970-6000 ext. 252
Facsimile: (510) 236-8951



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REPLY TO DECISION ON PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is in response to the Decision on Petition dated April 15, 2005, for which a response is due on or before June 15, 2005. Accordingly, this communication is timely filed.

Claims 1-49 are presently pending. Claims 2-7, 9-18, 20-22 and 24-49 have been withdrawn from consideration as a result of a final restriction requirement, from which Applicants petitioned on July 19, 2004 and which Petition was denied on April 15, 2005.

Applicants hereby request reconsideration of the Decision on petition and withdrawal of the Restriction Requirement, for the following reasons.

1. The Office has continually failed to address Applicants' request for evidence that synthetic peptides longer than 90 amino acid residues could have been generated, in

high yield and purity, by automated synthesis techniques available at the time the present application was filed. No such evidence was provided in the Decision on Petition.

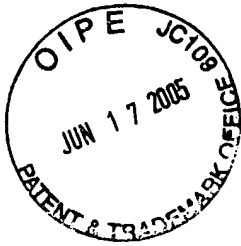
2. The Office has continually failed to address Applicants' request that the Office identify a natural source of the claimed proteins and nucleic acids. No such information was provided in the Decision on Petition.

3. The Office has continually failed to address Applicants' request that the Office provide evidence that one of skill in the art would have recognized, as of the filing date, that a nucleic acid encoding a non-naturally-occurring protein could have been used in a hybridization assay, and identify the target of any such hybridization assay.

4. Instead of addressing Applicants' requests for factual information (points 1-3 above), the Office provides an elaborate rationale for restriction in the present case based upon a Restriction Requirement in a co-owned case and appearing to suggest that, if the pending protein and nucleic acid claims were rejoined, it would result in the same invention being claimed in two applications without a possibility of the Office addressing double patenting issues. Applicants do not understand this reasoning, inasmuch as any double patenting issues in the present application can be addressed, and should properly be addressed, by a rejection of those claims that the Office believes are invalid for double patenting¹, not by refusing to consider them.

5. With respect to MPEP 803.02 (Decision on Petition, page 3), Applicants assert that the Office is confusing structure with sequence. As previously pointed out by Applicants, all claimed proteins, although having different sequences, share a similar structure (*see, e.g.* page 16, line 28 through page 18, line 5) which is related to their common function of DNA-binding. Structure does not equal sequence, as the Office has asserted.

¹ As was done in the Office Action dated March 18, 2004 (pages 6-7).



PATENT
USSN 09/989,994
Docket No. 8325-0011.20 (S11-US2)

CONCLUSION

For the reasons set forth above, as well as the reasons previously presented,²
Applicants respectfully request reconsideration and withdrawal of the Restriction
Requirement.

Respectfully submitted,

Date: June 14, 2005

By: Sean Brennan

Sean M. Brennan
Registration No. 39,917

Sangamo BioSciences, Inc.
501 Canal Blvd., Suite A100
Richmond, California 94804

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² See Responses mailed January 22, 2004 and July 19, 2004.